

PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of: :
SEAN R. WAKAYAMA : Atty. Docket No.: R-8767
Serial No.: 08/917,480 :
Filed: August 26, 1997 : Group Art Unit: 3641
Title: RECONFIGURATION CONTROL :
SYSTEM FOR AN AIRCRAFT WING :

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GROUP 3600

APPELLANT'S REPLY BRIEF UNDER 37 C.F.R. §1.193

Honorable Assistant Commissioner
for Patents
Washington, D.C. 20231

Sir:

Appellant, within a two (2) month period from the March 31, 2003, mailing date^{1/} of the Examiner's Answer, herein files a Reply Brief in accordance with the provisions of 37 C.F.R. §1.193(b).

With respect to the arguments advance by the Examiner in Section 11 (pages 3-5) of the Examiner's Answer, Appellant desires to make two points of clarification.

First, in the Brief filed December 19, 2002, Appellant argued that:

"the final rejection has again failed to comply with these minimum requirements. Appellant is left to guess which passages of the applied references are being relied upon in formulating the rejection. Moreover, Appellant can only speculate as to how the references are being combined and to what passage of which reference is being employed as supplying the motivation for the combination. For example, Appellant believes that the Final Office Action does address, i.e., suggest, replacement of the control system taught by the Ashkenas with that taught by Whitener. However, the

^{1/} May 31, 2003 falling on a Saturday.

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Final Office Action has expressly stated that the Examiner is **not suggesting a combination of these references**. As stated on page 4 of Paper No. 32,

"The Examiner in no way intended to suggest that the control system of Whitener be used in the Ashkenas' reference. It is clear from the teaching of Whitener (see column 10, last paragraph to column 11, lines 29) that Ashkenas' aircraft control surfaces have predetermined positions so as to perform certain flight maneuvers/conditions with optimized spanwise force distribution across the wing."

In the Examiner's Answer, the Examiner again asserts on page 4 that "the Examiner does not suggest moving the parts of Whitener or Lewis on the Ashkenas flight system." However, on page 5 of the Examiner's Answer, the Examiner states that:

"The Examiner would like to point out that the Examiner has used the decision by the [Board of Appeals] as a road map in treating the [respective] case. In the decision by the board (paper 15), the board suggested that the Examiner may wish to consider computer-based flight management systems, aircraft operating manuals, and pilot operating handbooks. The Examiner has done so by introducing the Whitener and Lewis to show that the claim subject matters are well known in the art and it would be obvious for one skilled in the art to have "combined" the references."

[Emphasis in the Examiner's Answer.]

Based on these assertions by the Examiner, Appellant is unable to fathom how the Examiner is actually employing the alternative secondary references in rejecting the pending independent claims.

Assuming *arguendo* that the Examiner is "combining" one of the secondary references in the classical sense, i.e., parts of Ashkenas are combined with teachings found in either Whitener or Lewis, the Examiner has failed to address Items (2) and (3)^{2/}, which are part of the minimum requirements

^{2/} 35 U.S.C. §103 authorizes a rejection where to meet the claim, it is necessary to modify a single reference or to combine it with one or more other references. After indicating that the rejection is under 35 U.S.C. §103, the examiner should set forth in the Office Action (1) the relevant teachings of the prior art relied upon, preferably with reference to the relevant column or page number(s) and line number(s) where appropriate, (2) the difference or differences in the

for establishing a "prima facie" case of obviousness. The Examiner has not identified which parts of the various references are being incorporated into a combination of elements which collectively renders the claimed invention obvious.

In contrast, assuming *arguendo* that the Examiner is asserting that one of ordinary skill in the art would know how to modify Ashkenas given the teaching of either Whitener or Lewis, Appellant is still left in the patently unfair position of rebutting the assertion that it would have been obvious to modify the Ashkenas system with the general knowledge of Whitener that suggests that something is possible since it *may* inherently produce results that are advantageous. This is not the fact based inquiry into obviousness dictated by 35 U.S.C. §103. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. See M.P.E.P. § 2143, citing *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990).

Secondly, the Examiner again assumes the inherency of an express limitation of the pending claims based on a the teachings of Lewis or Whitener without establishing any nexus between the teaching of the secondary references and the recitation in the pending claims. The Examiner assumes that there is a connection between a reference teaching that the position of a first control surface is controlled to increase in the local coefficient of lift and the other control surfaces are positioned to control pitch trim and optimum spanwise force distribution. The rejections do not establish any correlation between using the control surface configuration system as taught by Whitener in Ashkenas' system to increase the maneuverability of the aircraft and to prevent detrimental effects on the aircraft and the recited **"control surface reconfiguration system wherein, for each of a plurality of different flight conditions, the flight control surfaces are selectively reconfigurable to respective predetermined positions, which in combination, optimize the spanwise force distribution across the wing for each of the plurality of different flight conditions."** Stated another way, assuming

claim over the applied reference(s), (3) the proposed modification of the applied reference(s) necessary to arrive at the claimed subject matter, and (4) an explanation why such proposed modification would have been obvious to one of ordinary skill in the art at the time the invention was made. See M.P.E.P. §706.02(j).

that the control surfaces taught by Whitener operate as suggested by the Examiner, this cannot (and does not) establish that these control surfaces necessarily optimize the spanwise force distribution across the wing, especially the wing actually taught by Ashkenas. Since all of the references cited in rejecting the pending claims are silent with respect to optimized spanwise force distribution, no possible combination of the applied references can render any of the pending claims obvious.

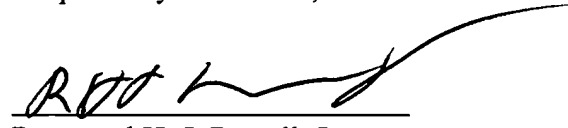
Pursuant to the foregoing, as well as to the arguments contained in Appellants' Appeal Brief dated December 19, 2002, Appellant respectfully requests that all of the Examiner's rejections be reversed, and that the application be passed to issue at the earliest opportunity.

Appellant does not wish to participate in an Oral Hearing. The Appellant respectfully requests that the Board act on the papers submitted in making its determination.

Respectfully Submitted,

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